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MADSON & METCALF
15 WEST SOUTH TEMPLE
SUITE 900
SALT LAKE CITY, UT 84101

EXAMINER	
HAILU, TADESSE	
ART UNIT	**PAPER NUMBER**
2173	

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/928,856	VIGIL ET AL.	
	Examiner	Art Unit	
	Tadesse Hailu	2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Amendment submitted/entered August 30, 2005.

2. The Applicant's Remarks that the applied art, Puskala (WO 02/070088) is simply not prior art under section 102(e) is considered. As Applicant's indicated Puskala (WO 02/070088) did not designate the United States, and as a result, WO 02/070088 is not considered to be a prior art under section 102(e). Thus, Puskala (WO 02/070088) is removed. However, another patent again by Puskala (US Pat No. 6,908,389) is applied to teach the present invention.

Status of the claims

3. The pending claims 1 through 40 are examined herein as follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 7, 8, 13-20, 23, 24, 29-35, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by Puskala (6,908,389).

With regard to claim 1:

Puskala discloses a hand-held wireless telecommunications device (Fig. 2, #**10**) configured to send a text message to a recipient (**20**) through use of a global computer network (**30, 43**), the wireless device (**10**) comprising:

a processor (**50**);

an input component (**60**) in electronic communication with the processor for a user to enter user input,

a display (**52**) in electronic communication with the processor that displays information to the User;

a communications module (**54**) in electronic communication with the processor for communicating with the global computer network;

memory (**56**) in electronic communication with the processor for storing data;

a messaging module (**62**) comprising instructions that are executable by the processor for implementing a method comprising:

connecting (**15**) the wireless device to the global computer network (Fig. 1);

displaying (column 12, lines 18-28) network data received from the global computer network on the display (e.g., Figs. 5b, 5C);

enabling the user to establish communications with a message web site (column 4, lines 27-59);

providing to the user a message user interface to select a message from a plurality of predefined ("preconfigured") messages (see Table 1), column 10, lines 5-column 10, lines 25), each of the plurality of messages being predefined to be sent to a recipient, wherein the messaging module receives the plurality of predefined messages from the message web site based on a user identification and displays the message user interface on the display thereby enabling the user to select the message from the plurality of predefined messages (column 11, lines 27-58);

providing to the user (e.g., wireless device **10**) a recipient user interface (e.g., list menu, Fig. 7B) to select the recipient (column 4, lines 12-15); and

sending (e.g., via communication link **15**) the message to the recipient (e.g., wireless device **20**) through the global computer network (column 11, lines 27-28)

With regard to claim 2:

Puskala further discloses that said hand-held wireless telecommunications device is a mobile telephone (Fig. 2).

With regard to claim 3:

Puskala further discloses that said hand-held wireless telecommunications device is a personal digital assistant (column 4, lines 30-31).

With regard to claims 4, 20 and 35:

Puskala further discloses that said message is a text message (Figs. 5A-5C).

With regard to claim 7:

Puskala further discloses that said message is an electronic mail messages (column 1, lines 12-15).

With regard to claim 8:

Puskala further discloses that said network data comprises Wireless Markup Language (WML) (column 6, lines 35-36).

With regard to claim 13:

Puskala discloses a web site (Fig. 1) for editing and storing preconfigured messages to be used with hand-held wireless telecommunications devices (e.g., devices 10 and 20), the web site comprising:

a web server (Fig. 1, column 8, lines 51-63) for serving web data to a plurality of wireless devices;

a computer (server at game platform 40, Fig. 1) enabling operation of the web server, the computer being in electronic communication with a storage device (Fig. 3, column 6, lines 45-column 7, lines 6) storing instructions executable by the computer for implementing a method comprising:

allowing a wireless device to contact the web site via a global computer network (column 4, lines 12-20);

receiving from the wireless device (e.g. device 10 or 20) user identification (column 2, lines 23-46);

sending an address list identified through use of the user identification from the web site to the wireless device (column 9, lines 5-47);

sending a plurality of preconfigured messages identified through use of the user

identification from the web site to the wireless device, each of the plurality of messages being predefined ("preconfigured") to be sent to a recipient (Figs. 5B-5C, column 9, lines 58-column 10, lines 14);

receiving a message and the recipient from the wireless device, wherein the message is selected from the preconfigured messages by a user through the wireless device, and wherein the recipient is selected from the address list by the user through the wireless device (column 12, lines 18-28); and

sending the message to the recipient through the global computer network (column 1, lines 39-42, column 11, lines 59-column 12, lines 17).

With regard to claim 14:

Puskala further discloses storing the preconfigured messages on the storage device (column 2, lines 23-46).

With regard to claim 15:

Puskala further discloses sending user interface data (e.g., menu list, Figs. 5A-5C) to a client computer to present an edit user interface on the client computer; and receiving a change from the client computer to change one of the preconfigured messages (column 7, lines 14-46, column 11, lines 27-58).

With regard to claim 18:

Puskala further discloses that server at platform 40 (web server) serves the web data to a plurality of mobile telephones (column 4, lines 27-59, Fig. 1, 10 and 20).

With regard to claim 19:

Puskala further discloses that server at platform 40 (web server) serves the web data to a plurality of personal digital assistants (column 4, lines 27-59).

With regard to claim 23:

Puskala further discloses that the message is an e-mail message and wherein the method further comprises e-mailing the e-mail message to the recipient through the global computer network (column 1, lines 11-38).

With regard to claim 24:

Puskala further discloses that the web data comprises WML (page 13, lines 15-17).

With regard to claim 29:

Puskala discloses a method for providing predefined ("preconfigured") messages (e.g., see Figs. 5A-5C, table 1) to a hand-held wireless telecommunications device (**10**) to be sent to a recipient (**20**) through use of a global computer network (**30, 43**), the method comprising:

establishing electronic communication between the wireless device (**10**) and the global computer network (**30, 43**) (Fig. 1);

establishing electronic communication between the wireless device (**10**) and a web site storing preconfigured messages (at message database **31**), each of the messages being preconfigured to be sent to a recipient (**20**) (column 2, lines 23-46);

retrieving destination address (address list) from the web site based on user identification (column 8, lines 51-63,);

sending the address list to the wireless device (column 5, lines 1-22, column 8, lines 51-63);

providing to a user (**10**) a recipient user interface to select the recipient from the address list (column 5, lines 1-22, column 8, lines 51-63);

retrieving the preconfigured messages from the web site based on user identification (column 5, lines 1-22, column 8, lines 51-63, column 12, lines 18-28);

sending the preconfigured messages to the wireless device (column 11,lines 59-column 12, lines 17);

providing to the user a message user interface to select a message from the preconfigured messages (Figs. 5A-5C, table 1, column 10, lines 14-29); and

sending the message to the recipient through the global computer network (column 1, lines 39-42, column 11, lines 59-column 12, lines 17).

With regard to claim 30:

Puskala further discloses providing a client user interface (e.g., menu list, FIG. 5A-5C) to a client computer via the global computer network (30, 43) to enable the creation of the preconfigured messages that are stored (31) on the web site (column 5, lines 1-22).

With regard to claim 33:

Puskala further discloses that the wireless device is a mobile telephone (Fig. 2, #10).

With regard to claim 34:

Puskala further discloses that the wireless device is a personal digital assistant (column 4, lines 20-31).

With regard to claim 35:

Puskala further discloses that the message is a text message (Figs. 5A-5C).

With regard to claim 37:

Puskala further discloses that the recipient user interface and the message user interface comprise WML instructions (column 6, lines 35-36).

With regard to claims 16, 17, 31, and 32:

Puskala discloses personal information data, such as destination database 32 at the game platform 40 and another destination database 65 at the wireless device. The destination databases 65 and 32, for example stores the predefined destination address of each player (column 5, lines 58-67). The wireless device user (e.g., device 10 or 20) is allowed to edit or modify the destination address 65. The wireless device user (e.g., PDA or device 10) also receives the pre-selected or predefined destination addresses form the host (game platform (40)) via the Internet and mobile network 30 (column 2, lines 23-46).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5, 6, 21, 22, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (US Pat No, 6,908,389) in view of Martin (US Pub No. 2002/0174106 A1).

With regard to claims 5, 6, 21, 22, and 36

While Puskala discloses a hand-held wireless telecommunications device (10) displaying a text message as defined in claim 1 (see Fig. 5A-5C), but Puskala does not describe that the message is a text message that includes a token. Puskala further fails to describe that the

messaging module allows the user to enter token text to replace the token in the message. Martin, however, discloses placeholder tokens, for data to be added by the user (paragraphs 65, 66, 70, 77 and 78).

Puskala and Martin are analogous art because they are from the same field of endeavor, text information processing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the placeholder tokens with text message data of Puskala will enhance the editing and sending of the text messages, because as suggested by Martin, one only has to replace the placeholder token, instead of rewritten the whole text messages (paragraphs 65, 66, 70, 77 and 78).

Therefore, it would have been obvious to combine Puskala with Martin to obtain the invention as specified in claims 5, 6, 21, 22, and 36.

6. Claims 9-12, 25-28 and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puskala (US Pat No, 6,908,389) in view of Graham (US Pub No. 2002/0178353 A1)

With regard to claims 9-12, 25-28 and 38-40:

Puskala describes customized application-specific software, which may be written in a language such as wireless markup language (WML) or Java, and alternatively, Puskala describes the messaging application 62 may comprise web access software (column 2, lines 23-46). But Puskala does not describe all HTML-compliant description languages, such as HTML, XHTML, HDML, and XML. However, Graham describes HTML, XHTML, HDML, and XML (see paragraph 32) as recited in the above claims.

Puskala and Graham are analogous art because they are from the same field of endeavor, electronic messaging.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the HTML-compliant description languages with Puskala's WAP browser software.

The suggestion/motivation for doing so would have been to provide a WAP user to browse HTML-complaint content using the mobile phone effectively.

Therefore, it would have been obvious to combine Puskala with Graham to obtain the invention as specified in claims 9-12, 25-28 and 38-40:

Response to Arguments

7. Applicant's Remarks/Arguments respect to claims 1-40 have been considered but are not persuasive. The Applicant argues that the cited references do not teach or suggest "sending a user selected predefined messages through a global computer network". In contrast to the Applicant's argument, Puskala, when combined with Martin or Graham discloses sending a user selected predefined messages through mobile network 30 or Internet 43 as illustrated and disclosed in Puskala (e.g., Fig. 1).

Conclusion

8. The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R 1.111(c) to consider this reference fully when responding to this action. The documents cited, **Ballard (US Pat No. 6,727,916)**, therein teach a typical wireless device comprising a messaging module as recited in claims 1, 13, and 29. Ballard further describes providing a user a message user interface (Quick

Text Choice, e.g., FIG. 6b) to select a message from a plurality of predefined messages, each of the plurality of messages being predefined to be sent to a recipient (see Fig. 6b, wherein device 100 is sending predefined text message to device 102). **Mahr (6,956,831)** teaches *all the limitations* of the independent claims (see Figs. 1-6, Abstract, and at least see column 5, lines 1-column 6, lines 16).

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 272-4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John Cabeca, can be reached at (571) 272-4048 Art Unit 2173.

10. An inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner Tadesse Hailu
Art Unit 2173
11/1/05